

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Figure 7. This sheet, which includes Figure 7, replaces the original sheet including Figure 7. Specifically, in Figure 7, the element originally labeled "1439" as been changed to "143."

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

REMARKS

Claims 1, 3-6, 9-12 and 15-17 are pending in the application. Claims 2, 7-8 and 13-14 have been cancelled.

In amended Figure 7, numerical label "1439" has been changed to numerical label "143." Support for this amendment can be found at least on page 46 of the specification at line 24. Accordingly, no new matter has been added by this amendment.

A. *Rejection of Claims 1, 3-6, 9-12 and 15-16 over Parikh, Higgins and Fink*

The Current Office Action rejects claims 1, 3-6, 9-12 and 15-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Parikh in view of Higgins and Fink '530. The stated grounds for this rejection is "reasons of record." As such, Applicants understand that the grounds for this rejection are the matters stated in the February 17, 2004 Office Action, which set forth the last outstanding grounds of rejection.

As discussed at Section B (pages 4-6) in the Appeal Brief filed by Applicants on September 10, 2004 (the "Appeal Brief"), the rationale for the obviousness rejection may be reduced to its constituent logic as follows: first, it would have been obvious to modify Parikh's interpolymer compositions that optionally comprise many additional ingredients, including HBEP, to provide the recited HBEP adhesive compositions. Then, since Parikh mentions his compositions can be extruded onto carpet backings, it would have been obvious to identify Parikh's composition as suitable for use as adhesive backcoats that were, in turn, suitable for use with the carpet and carpet tile structures of Higgins and Fink '530 to provide the claimed invention. Such multiple modifications allegedly would "meet all the structural and chemical limitations of the claim[s]" *i.e.*, the adhesive composition would: 1) not be integrally fused to the primary backing material; 2) be "substantially penetrated and substantially consolidated the [plurality of] fibers;" and 3) have resulted in a carpet or carpet tile having the recited tuft bind strength. The Examiner reasons this result because it is contended that Parikh's modified compositions would be "identical" in composition to the adhesive composition claimed by Applicants. (*See* August 7, 2003 Office Action at paragraph 4, pages 4-5.)

- i) ***The Federal Circuit has expressly held that the claims of a patent are not relevant for obviousness determinations; therefore, the rejection in view of Parikh is improper as a matter of law***

In paragraphs 3 and 4 of the Current Office Action, and as further described in paragraph 1 of the Examiner's Response to Arguments (starting on page 6 of the Current Office Action), Parikh's claims are again cited as prior art against the claimed invention. As demonstrated in the Appeal Brief, binding Federal Circuit law is unambiguous that the claims of a patent do not constitute prior art. *See In re Benno*, 768 F.2d 1340, 1345, 226 U.S.P.Q. 683, 686-87 (Fed. Cir. 1985). Therefore, the 5-95 % range set forth in Parikh's claims cannot be used as a basis for rejecting the claimed invention.

Notwithstanding the Federal Circuit case law directly on point, in paragraph 1 of Examiner's Response to Arguments of the Current Office Action, the Examiner states:

[I]t is argued [by the Examiner] that the claims of a patent are part of the printed document that is available to one skilled in the art under 35 USC 102. As such, the examiner believes that subject matter of [Parikh's] claims are properly relied on for the rejection at hand.

See Current Office Action at page 6, paragraph 8.1.

While Applicants appreciate that the Examiner believes that Parikh's claims constitute prior art, under no circumstances are an examiner's beliefs relevant to the legal basis of a rejection, such as whether or not the claims of a patent constitute prior art. To this end, the Examiner is reminded of the hierarchy of the source of legal authority to be applied in the examination of applications in the Patent Office:

Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, *i.e.*, decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. [citations omitted.] In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps.

Ex parte Anne Holt, 19 U.S.P.Q.2d 1211 (BPAI 1991) (emphasis added); *see also Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 U.S.P.Q. 2d 1152 (Fed. Cir. 1988) (stating that “the courts are the final authorities on issues of statutory construction. . .”).

In sum, clear and unambiguous Federal Circuit precedent states that the claims of Parikh do not constitute prior art. The Examiner has no choice but to follow this precedent. The rejection in view of Parikh’s claims is therefore improper and the rejection of the claims should be withdrawn on this ground alone.

ii) *The stated grounds of rejection is an improper “omnibus rejection”*

The stated grounds of rejection of claims 1, 3-6, 9-12 and 15-16 in view of the combination of Parikh, Higgins and Fink as presented in the Current Office Action is for “reasons of record.” This is an improper omnibus rejection. *See* MPEP § 707.07(d).

iii) *Case Law of 35 U.S.C. § 103(a)*

Since the rejections in paragraphs 3-6 of the Current Office Action are based on 35 U.S.C. § 103 (a), a short summary of the applicable case law is set forth below.

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1444 (Fed. Cir. 1991).

A combination of references must expressly or impliedly suggest all of the features of the claimed invention. *In re Gorman*, 933 F.2d 982, 986-987, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). In a proper obviousness rejection based upon a combination of any two or more prior art references, the motivation to combine must be found in the prior art. *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 U.S.P.Q. 303, 311-312 (Fed. Cir. 1983). Further, inherency cannot form the basis of an obviousness rejection because obviousness cannot be

predicated on what is unknown. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). It is irrelevant that each aspect of the invention was individually present in the prior art at the time of the invention. Rather, to negate patentability, there must be something in the prior art to suggest the desirability of combining these individual elements as claimed by the applicant. *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 U.S.P.Q.2d 31-32 (Fed. Cir. 1985).

iv) The prior art cited in paragraphs 3 and 4 of the Current Office Action

As previously noted, paragraphs 3 and 4 of the Current Office Action reincorporate the obviousness rejections made previously in the February 17, 2004 Office Action. Prior to addressing the rejections specifically, Applicants reincorporate the detailed, multi-page description of Parikh, Higgins and Fink '530 that were set forth in the Appeal Brief at Section C (pages 6-10). That discussion distilled the disclosures of each of those prior art references as the descriptions would be understood by one of ordinary skill in the art. Also, that detailed discussion serves as the basis of Applicants' arguments herein.

v) Parikh does not teach or suggest that homogenously linear or substantially linear ethylene/alpha olefin interpolymers independently possess adhesive properties

As argued by Applicants in the Appeal Brief at Section D(5) (pages 14-15), Parikh is absolutely silent as to whether homogenously linear or substantially linear ethylene/alpha olefin interpolymers independently possess any adhesive properties. In response to this argument, the Examiner states in paragraph 5 of the Response to Arguments section that "it is well known in the art that thermoplastic adhesives can function as backcoat adhesives." The Examiner seems to be contending that *ALL* thermoplastic polyolefins are suitable for use as hot melt adhesives, and therefore, it would be obvious to use the specifically claimed thermoplastic polyolefin. This logic is flawed: just because some thermoplastic adhesives might have adhesive properties does not suffice for an obviousness rejection unless there is also some teaching or suggestion to select the specifically claimed material (*i.e.*, HBEP) as well as a further teaching that the HBEP would possess the necessary adhesive properties. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992).

The record shows that the only disclosure of the adhesive properties of HBEP is in Applicants' own disclosure. It is well settled that Applicants' disclosure cannot be used as a roadmap to result in the claimed invention because this constitutes hindsight reasoning. Put another way:

To rely on an equivalence known only to the applicant to establish obviousness is to assume that his disclosure is part of the prior art. The mere statement of this proposition reveals its fallaciousness.

In re Ruff, 256 F.2d 590, 596, 118 U.S.P.Q. 340, 346-347, 118 U.S.P.Q. 340 (C.C.P.A. 1958), *see also In re Kuehl*, 475 F.2d 658, 177 U.S.P.Q. 250, 253-54 (C.C.P.A. 1973) (indicating that an examiner cannot generally use new information regarding an invention disclosed in the as-filed application to support an obviousness rejection). Thus, the obviousness rejection is in error for this additional reason. Applicants also incorporate by reference the additional arguments made in this regard in the Appeal Brief.

vi) *It would not have been obvious to modify Parikh's ranges*

As noted above, the primary basis of the obviousness rejection set forth in paragraphs 3 and 4 of the Current Office Action is flawed because the claims of a patent do not constitute prior art. The rejection should be overruled for this reason alone. However, to ensure that Applicants are able to address the other numerous grounds for error in the obviousness rejections of paragraphs 3 and 4 of the Current Office Action, it will be assumed for the purposes of the instant Amendment that it would be contended that alternate disclosure is present in Parikh that would serve to form the basis of an obviousness rejection.

To this end, the rationale of the re-incorporated obviousness rejection of paragraph 3 of the Current Office Action starts first with an identification of a range of materials, in particular, the range of interpolymer main components and the optional extending or modifying composition of which homogenously linear or substantially linear ethylene/alpha olefin interpolymer is a possible type. Reviewing Parikh's specification for the disclosure of "base polymer" *i.e.*, the interpolymer adhesive material, apart from Parikh's claims, the only other range of amount of interpolymer adhesive material in Parikh is 60 to 40 %. (Parikh, col. 11-12, lines 63-5.) While the numerous optional ingredients can be varied within the specified ranges, there is no other

express range disclosed for the amount of interpolpolymer component. Thus, this 60 to 40 % range would have to form the basis of an alternate obviousness rejection relating to the range of materials in Parikh's compositions.

Using this 60 to 40 % range as the starting point for modification of the amount of interpolpolymer, there must be a teaching or suggestion to reduce the amount of main interpolpolymer adhesive and to increase the amount of the optional extending or modifying composition (of which HBEP is only one of several types that can be used) to beyond the 5 to 75 % disclosed in Parikh to result in the about 80 to about 99 % HBEP claimed by Applicants. This teaching or suggestion is clearly absent from Parikh.

The extending or modifying compositions are just that—extenders or modifiers. Indeed, it is clear from Parikh's disclosure that this is the material that provides the adhesive qualities of the composition when it is stated:

The subject invention pertains to olefin-based compositions. In particular, the subject invention pertains to compositions comprising at least one substantially random interpolpolymer of at least one alpha-olefin and a vinylidene aromatic monomer or a hindered aliphatic vinylidene monomer, preferably at least one substantially random, interpolpolymer of ethylene, optionally at least one alpha-olefin and a vinylidene aromatic monomer, in conjunction with at least one tackifier, and optionally at least one extending or modifying composition or processing aid.

(Parikh, col. 1, lines 11-20.)

Parikh further states that "the industry seeks to improve the applicability of these substantially random interpolpolymers." (Parikh, col. 1, lines 36-38.) From this and other statements in Parikh, one of ordinary skill in the art would understand that Parikh's disclosure is directed toward one end—to improve the performance of the substantially random interpolpolymer materials.

It defies logic to contend that one of ordinary skill in the art would read from Parikh a teaching or suggestion to *decrease the amount of the main ingredient* of Parikh and to at the same time *increase the amount of this optional secondary material* to the greater amount claimed by Applicants. There is simply no motivation to modify the ranges of Parikh to result in adhesive

composition recited by Applicants. Therefore, the rejection should be overruled for at least this reason.

The Examiner addresses the above arguments in paragraph 2 of the Response to Arguments section of the Current Office Action by reiterating, without support, that one of ordinary skill in the art would be motivated to increase the modifier (that is, the optional secondary material in the composition) to result in the claimed “about 80 %” HBEP.¹ Such an unsupported assertion does not constitute the factual grounds required to support an obviousness rejection. *See In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Thus, the obviousness rejection of paragraph 3 remains insufficient as a matter of law.

vii) *The principal of operation of Parikh would be altered by the proposed modification*

In the Appeal Brief, Applicants argued in Section D(3) (page 13) that the principal of operation of Parikh would be changed by the modification proposed in the rejection using Parikh as a primary reference. These arguments are reincorporated herein. In response, the Examiner contends in paragraph 3 of the Response to Arguments that because Parikh teaches that the optional ingredient of HBEP may be present in Parikh’s compositions at up to 75 % by weight, Parikh “explicitly teaches an adhesive composition comprising primarily HBEP is within the scope of the disclosed invention.” This rationale wholly ignores Applicants’ arguments that Parikh would no longer be an interpolymer composition if the modification proposed by the Examiner were made to Parikh’s compositions.

In particular, Parikh addresses interpolymer compositions where homogeneously linear or substantially linear ethylene/alpha olefin interpolymers are *optional extending or modifying* ingredients. If the amount of homogeneously linear or substantially linear ethylene/alpha olefin interpolymer was increased as proposed in paragraphs 3 and 4 of the Current Office Action, Parikh’s compositions would no longer relate to interpolymer adhesive compositions with properties modified by other materials. Rather, such modified compositions would relate to compositions based upon optional and secondary materials with unknown adhesive properties.

¹ Of course, the rationale is based on an improper contention that Parikh’s claims constitute prior art.

The proposed modification would therefore change the principle of operation of the reference and is accordingly improper. *See In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 351 (C.C.P.A. 1959).

viii) *The Current Office Action is reading the Parikh reference out of its context*

In paragraph 4 of the Examiner's Response to Arguments in the Current Office Action, the Examiner contends that "applicant is reading the disclosure too narrowly." After excerpting portions of Parikh, the Examiner states that "[o]ne skilled in the art would reasonably presume that the 5-75 % range [of the extending or modifying component] is applicable to all of the disclosed compositions suited for said modifier." Applicants assert that this rationale continues to constitute a selective reading of Parikh that is not supportable when the Parikh disclosure is read as a whole. In particular, the Examiner's reading of Parikh selects only those portions of Parikh that will support the obviousness rejection. This is improper. In support of this contention, Applicants herein reincorporate the arguments set forth in the Appeal Brief.

It is improper to pick and choose from any one reference only so much of it that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238, 240, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). The rejection should be overruled for this additional reason.

ix) *Parikh does not provide a "clear and particular" teaching or suggestion of the use of those compositions as a backcoat type adhesive*

In paragraph 6 of the Examiner's Response to Arguments in the Current Office Action, the Examiner contends that a "clear and particular" teaching or suggestion is present that Parikh's compositions can be used as backcoat-type adhesives. Specifically, it is stated:

It is the examiner's position that Parikh teaches hot melt adhesives which can be extruded onto to substrates such as carpet backings. In the carpet art, one of ordinary skill would readily understand this teaching to mean an adhesive backcoat. Support for this position is first found in the conventional use of hot melt adhesives extruded onto tufted backings for encapsulating said tufts. Note the teachings of the Higgins and Fink references.

In contending that Examiner has provided the requisite clear and particular teaching to support the obviousness rejection, the Examiner again resorts to vague and unsupported statements as to what is allegedly “conventional” in the art. Moreover, it is even more vague to allege further support by directing Applicants to “[n]ote the teachings of the Higgins and the Fink references.” Nothing is clear and particular about a general direction to Applicants to “note” the entirety of two references for the required particularized support for the rejection. In sum, the Examiner again fails to point out the express teachings or suggestions in the cited prior art to support her obviousness rejections. The failure of the Examiner to articulate a *specific* understanding or principle that would motivate one of ordinary skill in the art to arrive at Applicants’ invention gives rise to an inference that the obviousness rejection was based upon a hindsight reconstruction. *See In re Rouffet*, 149 F.3d 1350, 1358, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Applicants assert that one of ordinary skill would not “readily understand [Parikh’s teaching of extrusion of adhesive onto a carpet backing] to mean an adhesive backcoat” as contended by the Examiner. Adhesives can be used elsewhere in carpet backings. For example, adhesives are used to adhere a secondary backing material to a primary backing material. (*See As-Filed Specification* at page 42, lines 22-27.) Also, adhesives can be used on carpet backings to provide a “peel and stick” feature. (*See As-Filed Specification* at page 48, lines 10-17.) The Examiner has pointed to nothing in Parikh that would give rise to a “clear and particular” understanding that one of ordinary skill in the art would read Parikh’s disclosure as the Examiner alleges, rather than in either or both of these alternate adhesive aspects.

As discussed in detail in the Appeal Brief, Applicants continue to assert that there is no “clear and particular” teaching or suggestion that Parikh’s adhesives would be used as contended by the Examiner and that materials can be combined with Higgins and Fink ‘530. *See In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999). Therefore, the obviousness rejection is improper for at least this additional reason.

- x) ***Parikh presents no reasonable expectation of success that those compositions may be used as backcoat adhesives to provide the claimed carpet and carpet tiles***

In paragraph 7 of the Examiner's Response to Arguments section of the Current Office Action, the Examiner contends that "there is nothing on record establishing that the compositions would not function [as adhesive backcoat compositions]" thus allegedly resulting in one of ordinary skill in the art have a reasonable expectation of success.

This statement is clearly erroneous. First, as argued by Applicants in the July 22, 2002 Request for Reconsideration, Table A of Fink clearly shows that some polyolefin materials function as suitable adhesive backcoat materials, whereas other polyolefin materials do not. In particular, polyethylene materials are shown to not be suitable for this use. This is demonstrated in Table A at the column entitled, "Bond Strength @ 100 %." This table describes how well the materials identified in column 1 of Table A will function as carpet backing adhesives. In short, Table A of Fink '530 clearly demonstrates that polyethylene materials are not suitable for use as precoat adhesives. Additionally, Applicants' own disclosure shows that prior art polyethylene materials do not provide good tuft bind strength. (See As-Filed Specification at pages 51-53, in particular Tables 1 and 2.) The Examiner is therefore incorrect in her assertion that nothing in the record discounts a reasonable expectation of success that HBEP, which is a polyethylene material, would function as an adhesive precoat. Applicants again assert that there is not a reasonable expectation of success that Parikh's compositions would function as backcoat adhesives to provide a carpet with the claimed features.

- xi) ***Parikh is not analogous prior art to the claimed invention***

Paragraph 8 of the Examiner's Response to Arguments in the Current Final Office Action states that Parikh is analogous prior art because it addresses adhesive polymers. Applicants stand by their previous arguments that Parikh is not analogous art to claimed invention and, as such cannot be used as the basis of an obviousness rejection.

In particular, the reasonable reading of Parikh's disclosure is that it relates to pressure sensitive adhesives. Such materials are used to glue or laminate a structure to another surface. The present invention relates to, in part, backcoat adhesives for carpet or carpet tiles and the structures formed therefrom. As contended in paragraph 10 of the Examiner's Response to

Arguments, to function as an adhesive backcoat material must “have sufficient flow (*i.e.*, low enough viscosity) to wet and penetrate the backing surfaces and tuft stitches (*i.e.*, encapsulate and/or consolidate the fibers).” In contrast, the adhesives of Parikh are used to adhere two surfaces together. This function is clearly demonstrated by the emphasis on “T-peel strength” in the Examples. (*See* Parikh at Examples.) Parikh makes no mention how the flow or viscosity of those adhesive compositions might relate to carpet systems, nor does it make any reference to the ability of the adhesive to wet and penetrate a backing surface. This is not surprising because pressure sensitive adhesives, whether applied *via* hot melt coating processes or otherwise, are intended to remain *on* a surface as opposed to penetrating *into* a surface. If such materials possessed the flow and viscosity characteristics needed to penetrate a primary backing and encapsulate carpet fibers, it would be expected that such an adhesive would not be suitable for the uses described in Parikh.

In sum, the Parikh reference is neither from the same field of endeavor of Applicants’ invention, nor is it reasonably pertinent to the particular problem with which the inventor is involved. Therefore, Parikh is not properly cited against the claimed invention. *See e.g., In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992).

xii) Fink ‘530 appears to be cited in error

In paragraph 9 of the Examiner’s Response to Arguments, the Examiner states that Fink ‘530 was not cited in error. Instead, the Examiner states that Fink is used for its generalized teachings of “what is known in the art (*e.g.*, conventional carpet construction).” Applicants believe that they have overcome the rejection based upon Fink ‘530 by at least the inclusion of the phrase “wherein the adhesive composition is not integrally fused to the primary backing material.” The Examiner acknowledged this and withdrew Fink’s counterpart PCT publication as a reference in paragraph 2 of the January 15, 2003 Office Action. Further, as discussed below, Fink ‘530 states that hot melts do not work as backcoat adhesives unless they are integrally fused with the primary backing. In view of this previous amendment, it was improper for the Examiner to continue citing this reference. In further support of this assertion, Applicants incorporate by reference the argument presented in Section D(9) (page 17) of the Appeal Brief.

xiii) The secondary references do not supply the carpet or carpet tile aspects of Applicants' claims

As further grounds of error in the obviousness rejection, even assuming that Parikh contains a teaching or suggestion that the compositions therein can be modified as contended by the Examiner and that Parikh teaches or suggests that these modified compositions for use as an adhesive backcoat, neither Higgins nor Fink '530 supply the additionally claimed aspects.

As discussed, Parikh discloses only hot melt adhesive compositions, where one of the proposed uses for these compositions can be a non-specified incorporation in carpet backings. At least the following claimed aspects of Applicants' invention are missing from the Parikh disclosure:

- a. a primary backing material having a face and a back side;
- b. a plurality of fibers attached to the primary backing material and extending from the face of the primary backing material and exposed at the back side of the primary backing material; and
- c. the adhesive composition is not integrally fused to the primary backing material, and wherein the carpet has a tuft bind of 5 pounds or more as measured according to ASTM D-1335-67.

See Claim 1, Current Listing of Claims.

In order for the combination of Parikh, Higgins and Fink '530 to render the claimed invention obvious, the resulting combination must set forth *each and every element*. Therefore, each of the aspects of the above excerpted portion of claim 1 must be present in both Higgins and Fink '530. Since Higgins and Fink '530 address carpet products, each includes a disclosure of the first two excerpted elements reproduced above *i.e.*, primary backing and fibers. However, neither reference teaches nor suggests the additional excerpted portion C of claim 1.

To address this clear deficiency in the rejection, in the Examiner's Response to Arguments, the Examiner again states that these aspects of the claimed invention are "conventional." However, Fink '530 expressly contradicts this assertion. In its background section, Fink '530 first discusses latex backings for carpet structures which are reportedly used in "80-90 % of all carpet made in the United States." (See Fink '530 col. 1, line 52 – col. 2, lines 1-7.) Fink '530 then goes on to describe methods of using hot melts as backcoats. (Fink '530,

col. 2, lines 18 – col. 2, line 46.) However, Fink ‘530 states that those conventional hot melt adhesives “do not result in reproducible consistency regarding scrim bonds, tuft pull strength and fuzz resistance.” (Fink ‘530, col. 4, lines 13-14.) Thus, Fink ‘530 discloses that “conventional” (as termed by the Examiner) hot melts do not function suitably as adhesive backcoats. In other words, Fink ‘530 teaches that hot melts “conventionally” do not work as backcoat adhesives and, contrary to the Examiner’s assertions, Fink ‘530 teaches away from the use of hot melt adhesives for use as backcoats (whether “conventional” or otherwise) unless the hot melt adhesives are integrally fused with the primary backing. As such, the Examiner’s reliance that hot melt adhesives are “conventional” for use as backcoat adhesives is directly in opposition to the teaching of Fink ‘530.

Higgins presents no details how hot melts can be used as backcoat adhesives. Therefore, it does not support the Examiner’s contentions that hot melt adhesives are “conventional” as claimed by Applicants.

Other arguments regarding the sufficiency of Higgins and Fink ‘530 were presented in Section D(10) (pages 17-18) in the Appeal Brief. Those arguments are incorporated herein.

xiv) Fink ‘530 teaches away from the “not integrally fused” aspect of the claims

Fink ‘530 requires that the adhesive be integrally fused to the primary backing. This disclosure is in direct contradiction to the claims which recite that the adhesive composition is “not integrally fused to the primary backing.” This expressly opposite result from that dictated in Fink ‘530 means that this reference cannot form the basis of an obviousness rejection. This is the essence of “teaching away.” *See Gore*, 721 F.2d at 1550-51, 220 U.S.P.Q. at 311. Other arguments made in regards to this section that were made in the Appeal Brief are hereby incorporated herein.

xv) The combination of Parikh with Higgins and Fink ‘530 improperly relies on allegedly inherent features as the basis of an obviousness rejection

In the Appeal Brief at Section D(11) (pages 18-19), Applicants discussed the absence of disclosure in the Higgins and Fink ‘530 references and how reliance on such absent features means that the Examiner must necessarily be relying on the allegedly inherent features of the

Higgins and Fink '530 references to provide the obviousness rejection. Applicants incorporate herein those previous arguments. The reliance on inherent features to make an obviousness rejection is legally improper. *See In re Spormann*, 363 F.2d 444, 448, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966) (stating that "obviousness cannot be predicated on what is unknown.")

In paragraph 11 of the Examiner's Response to Arguments, the Examiner contends, without supporting case law or MPEP citation, that "it is not improper to assume that the combination of prior art that produced a like chemical and structural materials would also have like properties." This statement begs the question: if the Examiner assumes that the combination of the prior art gives the desired result (*i.e.*, the claimed invention), then the desired result will follow. Of course, such logic is circular and legally improper. Applicants reiterate that a combination of prior art does not give the claimed invention and any contention by the Examiner to the contrary would require non-disclosed features of the cited prior art to be relied upon in the obviousness rejection.

xvi) *The data of Applicants' specification demonstrate that "all hot melt type adhesives are not created equal"*

In the Appeal Brief at Section D(12), Applicants asserted that the rejection ignores the data in both Applicants' disclosure and in Fink '530 as to the performance of adhesive materials. Applicants incorporate those arguments herein. Paragraph 12 of the Examiner's Response to Arguments wholly ignores this data. It is requested that this data be given appropriate consideration in that it contradicts the Examiner's contention that hot melt adhesives of similar composition will provide equivalent tuft bind performance as adhesive backcoat materials.

xvii) *Other grounds of error resulting from the obviousness rejection in view of Parikh, Higgins and Fink '530*

Applicants believe that the above discussion clearly demonstrates that the obviousness rejection of paragraph 3 of the Current Office Action is improper for a number of reasons. However, to preserve their rights to make additional arguments in a later proceeding, if necessary, the following additional grounds for error in the Final Office Action are briefly discussed.

1. *The Current Office Action improperly takes from Parikh a description of an improvement as the motivation to modify those compositions*

Applicants incorporate herein the assertions made in the Appeal Brief at Section 14(a) (pages 19-20) relating to the Examiner's failure to define how the alleged improvement to tack and modulus demonstrates a motivation to modify the amount of HBEP in Parikh's compositions. In response, in paragraph 14(a) of the Examiner's Response to Arguments, the Examiner continues to contend that the motivation is to improve the "tackiness" and "modulus" of Parikh's compositions. However, the Examiner fails to show why an improvement in tack and modulus would be relevant to an adhesive backcoat composition so as to support a suggestion to modify and then use Parikh's compositions as contended by the Examiner. Thus, the alleged motivation is not tied to any aspect of the claimed invention and, accordingly, is improper.

2. *Parikh's pressure sensitive adhesives would not be suitable for use as claimed by applicants*

In the Appeal Brief at Section 14(b) (page 21), Applicants argued that Parikh's compositions would not be suitable for use as claimed. In paragraph 14(c), the Examiner does not counter this argument. Applicants reincorporate that previous argument.

3. *The Current Office Action wholly fails to address the recited aspects of "substantially penetrated and substantially consolidated"*

As noted above in Section 14(d) (page 22), the Office Action did not address in any manner the recited aspects of "substantially penetrated and substantially consolidated the [plurality of] the fibers." To be legally sufficient, an obviousness rejection must specifically address each claimed aspect. The Examiner contends that this claimed aspect was incorporated by reference in the August 7, 2003 Office Action. This Office Action was not the rejection of record in the February 17, 2004 Office Action to which the Appeal Brief responded. Again, the Examiner's bootstrapping of multiple previous rejections makes the record unclear and prejudices Applicants ability to respond appropriately and fully to the rejections of record.

B. *Claim 17 stands rejected under 35 U.S.C. § 103(a) over Parikh in view of the Higgins and Fink as applied to claims 1 and 16 above, and further in view of Jialanella for "reasons of record."*

First, this rejection is virtually identical to the rejection stated previously in the February 17, 2004 Office Action. As such, Applicants reincorporate the arguments made above,

whereby the numerous grounds of error in the rejection of the remaining claims of record are discussed. As shown above, the legal and factual rationale for the rejections of claims 1, 3-6, 9-12 and 15-16 over the combination of Parikh, Higgins and Fink '530 cannot be sustained. The rejection of claim 17 must also fail for these same reasons.

C. *Claims 1, 3-6, 9-12 and 15-16 stand rejected over Higgins and Fink '530, in view of the Lai patents*

In paragraph 5, the Examiner rejects claims 1, 3-6, 9-12 and 15-16 over Higgins and Fink '530 in view of the Lai patents.

In particular, the Current Office Action cites the previously identified sections of Higgins and Fink '530 where such sections mention hot melt coatings and carpet materials. In relying on Fink '530 for these alleged teachings, the Current Office Action cites the background section of this reference. As discussed above, contrary to the statements in the Current Office Action, this section of Fink '530 clearly teaches that "conventional" hot melt adhesives do not work as adhesive backcoats. (See Fink '530, cols. 2-4.) Thus, Fink '530 cannot support the contention that "selection of suitable hot melt adhesives are for backcoat applications is within the level of ordinary skill in the art." (See Current Office Action, paragraph 5.) Indeed, if one of ordinary skill in the art could not get hot melts to function suitably as adhesive backcoat materials in Fink '530, how could such technology be within the abilities of one of ordinary skill in the art? Further, as discussed above in Table A, Fink '530 demonstrates that polyethylene is unsuitable for use in adhesive backcoat formulations.

Moreover, as further discussed, Higgins provides no detail whatsoever as to what and how hot melt adhesives can be used as adhesive backcoats. Thus, this reference gives no support for the rejection.

There is no teaching or suggestion that Higgins and Fink '530 can be combined with the Lai patents. Indeed, neither Higgins nor Fink '530 mentions, either explicitly or implicitly, that HBEP can be used as an adhesive backcoat. Neither Lai patent indicates that the polymeric materials described in those references could function as adhesives. As noted above in Section 7(C), the only identification of the adhesive capabilities of HBEP is in Applicants' own

disclosure. The use of Applicants' disclosure for a required teaching is the very essence of improper hindsight reconstruction.

The Examiner further states in paragraph 5 that:

carpet comprising the teachings of the cited prior art would meet the claimed tuft bind strength in that said prior art meets the structural and chemical limitations of the claims. It follows that said prior art must have the same physical properties.

This logic expressly ignores the requirement for a teaching or suggestion that the references can be combined. Rather, this statement readily shows that the Examiner is merely adding the various disclosures together to provide the sum of the parts which (as she sees it) disclose the recited invention. Of course, without the teaching or suggestion that the references can be combined, the rejection is improper.

Lastly, the Examiner takes Official Notice of there being labels and/or literature on commercial carpet in the U.S. Applicants respond that the primary basis of the rejection cannot be sustained and, as such, the Examiner's Official Notice, whether supportable or not, is not sufficient to render claim 9 obvious.

D. *Claim 17 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the cited Higgins, Fink '530 and Lai patents as applied to claims 1 and 16 and further in view of Jialanella.*


The rejection of paragraph 6 of the Current Office Action is based upon the combination of Higgins, Fink '530, the Lai patents and an additional reference, Jialanella. As noted, Higgins, Fink '530 and Jialanella cannot be combined to render the claimed invention obvious. Therefore, it follows that these references cannot be combined with Jialanella to render claim 17 obvious.

CONCLUSION

In light of the Amendments and Remarks submitted herein, it is believed that the claims are in condition for allowance and Applicants respectfully seek notification of same.

A Credit Card Payment Authorization Form PTO-2038 authorizing payment in the amount of \$1240.00, representing \$790.00 for the concurrently filed Request for Continued Examination and \$450.00 for the required fee pursuant to the enclosed Request for Two-month Extension of Time, is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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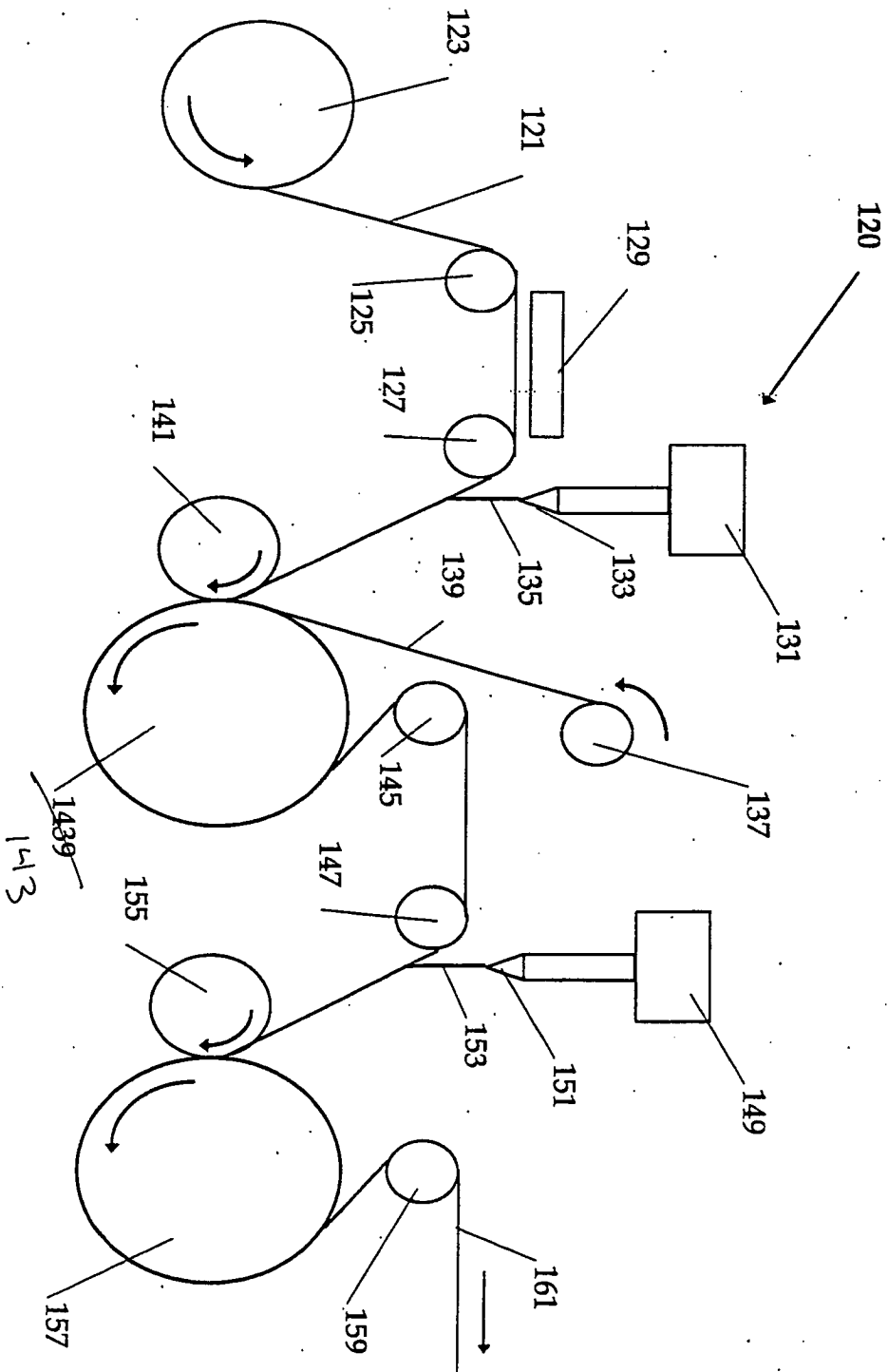


Figure 7

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